



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,973	02/04/2004	Steven C. Shanks	206-024	5207
33354	7590	11/01/2006		EXAMINER
ETHERTON LAW GROUP, LLC 5555 E. VAN BUREN STREET, SUITE 100 PHOENIX, AZ 85008			JOHNSON III, HENRY M	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/772,973	SHANKS ET AL.
	Examiner	Art Unit
	Henry M. Johnson, III	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 August 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4,10,14-29,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 4,10,14-29,31 and 32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 February 2005 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 082106.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

Response to Arguments

Applicant's arguments filed August 21, 2006, with respect to the rejection of claims 4 and 6 as unpatentable over Orosz in view of O'meara have been fully considered and are persuasive. However, new rejections follow using Yayama and Gerdes.

The applicant's argument that Yayama fails to suggest the laser sources in a housing is not consistent with either the probe with internal source of the prior art disclosed by Yayama or the disclosure of the use of a probe that is pushed against a surface by Yayama for the three-color device.

The applicant's background disclosure provides teachings that the variables of a laser device are well known to one of skill in the art and therefore, controllers to provide energy levels, pulse durations and repetition rates would be obvious to a skilled artesian.

Devices disclosing optics for various spot sizes (i.e. Gerdes) are well known. Specific spot configurations are not disclosed by the applicant as solving a particular problem or yielding unexpected results, rendering these to one of design choice.

Applicant's arguments regarding suggestions about treating the parasympathetic nervous system by the prior art are irrelevant as they relate to intended use and there is no mention or citation of such in the claims. The claims, not the specification, define the invention. In re Sporck, 386 F.2d 924, 155 USPQ 687 (CCPA 1968). Specifically, it is improper to read limitations from the specification into the claims. In re Winkhaus, 527 F.2d 637, 188 USPQ 129 (CCPA 1975).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4, 10 and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,582,454 to Yayama in view of U.S. Patent 6,267,779 to Gerdes. Yayama teaches a device for treating the parasympathetic nervous system using blue, green and red lasers (Col. 4, lines 9-15), independently controlled by a drive control unit (Fig. 2, # 2). The laser power is from 1 to 5 mW and pulse rates from a few Hz to 1KHz. The beams may be arbitrarily adjusted implying simultaneous operation (Col. 5, lines 12-24). Optics are provided for each beam to condense the beams (Col. 4, lines 17-18), such condensing being interpreted as shaping the beam. The optics may vary the width of the beams (Col. 5, lines 25-30). Yayama teaches prior art probes with internal sources (Fig. 1A), thus inherently teaching the sources are in the hand-held probe. Yayama teaches a probe that is pushed against the tissue surface for treatment (Col. 6, lines 1-6), this interpreted as being freely movable by an operator. Yayama does not teach different spot shapes. Gerdes discloses an apparatus for therapeutic laser treatment that includes handheld wands (Fig. 7) that each may deliver two wavelengths of laser energy. The beams are combined and delivered to the wands, which include adjustable optics to focus and shape the beams (Col. 8, lines 31-34). The beam shape may be circular or rectangular (Col. 9,

Art Unit: 3739

line 49), or a variety of other patterns. The rectangular shape is interpreted as a linear shape by assigning a minimal value to the "Y" dimension. A controller for the sources is disclosed that may control the pulse parameters, including, continuous or pulsed, pulse duty cycle and duration of application for each of the radiation sources synchronously or independently with continuous operation possible by selection of a duty cycle of 100 percent (Col. 11, lines 3-8). Specifically mentioned is a pulse frequency of one hertz (Col. 11, line 63). It would have been obvious to one skilled in the art to use optics to produce various beam shapes as taught by Gerdes in the invention of Yayama as such optics are well known in the art and both Gerdes and Yayama suggest varying the beam for specific treatments. It is noted, that while specific spot shapes are cited, no criticality is associated with any specific shape.

It is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

Claims 20-29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,582,454 to Yayama in view of U.S. Patent 6,267,779 to Gerdes and further in view of U.S. Patent 5,150,704 to Tatebayashi et al. Yayama and Gerdes are discussed above, but do not teach a support means with three-dimensional positioning. Tatebayashi et al. teach a laser therapeutic apparatus for treating a patient by irradiating selected body parts by laser radiation, the laser diode sources being supported by a common support table (abstract). The table teaches a support means positionable in the X, Y and Z axis (Col. 2, line 60). The laser probes include a laser diode, a driver circuit, and one or more optical lenses (Col. 8, lines 6-20). Tatebayashi et al. is considered for the three-dimension support teaching. The position of the

components is considered a design choice since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the support as taught by Tatebayashi et al. with the invention of Yayama/Gerdes to relieve the doctor of the task of holding the probes as disclosed by Tatebayashi et al. to better focus the treatment and reduce human error.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

Art Unit: 3739

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Henry M. Johnson, III
Primary Examiner

Art Unit 3739


HENRY M. JOHNSON, III
PRIMARY EXAMINER